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EXAMINER

KOENIG, ANDREW Y

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/966,759

**Applicant(s)**

HENDRICKS, JOHN S.

**Examiner**

Andrew Y. Koenig

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/02, 3/17/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites, "sending to a television associated with the subscriber," which is unclear in that claims does not indicate what is being sent to the television. In order to remain consistent with other claims, "sending to a television associated with the subscriber," will be interpreted as "sending the channel selection to a television associated with the subscriber" for the rest of this Office Action.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4 and 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 5,231,494 to Wachob (Wachob '591).

Regarding claim 1, Wachob '494 teaches associating a first video program with a first channel (see figure 2, label 40 – RF Modulator A, col. 5, ll. 43-55), and a second program with a second channel (see figure 2, label 42 – RF Modulator B, col. 5, ll. 43-55), Wachob '494 teaches receiving from a subscriber input device (I/R remote control – 74) a channel selection (col. 6, ll. 9-18), which in turn sends the channel selection to a television associated with the subscriber (col. 6, ll. 18-23).

Regarding claim 2, Wachob '494 teaches receiving from a subscriber input device (I/R remote control – 7) a channel selection for display on a television (col. 6, ll. 9-23), and associating plural video programs with a plurality of channels (col. 5, ll. 43-55), and sending at least one of the video programs without regard to the channel selection in that Wachob '494 teaches selecting the commercial (claimed at least one of the video programs) without regard to channel selection (col. 5-6, ll. 56-6).

Regarding claim 3, Wachob '494 teaches that the video program comprises advertisements that are demographically targeted to the subscribers based on a profile associated with the subscriber (col. 5-6, ll. 56-6).

Regarding claim 4, Wachob '494 teaches receiving at a set top terminal a television signal (see tuner/demodulator – fig. 2, label 62, col. 6, ll. 7-9), wherein the demultiplexer and decompressor (fig. 2, label 66) extracts individual television programs

Art Unit: 2623

from the signal (col. 5-6, ll. 67-3, col. 6, ll. 13-23). Wachob '494 teaches associating the programs with channels available for selection by a subscriber using a user input device (remote control - col. 6, ll. 9-18), wherein the programs are displayed on a television associated with the subscriber (col. 6, ll. 18-23). Further, Wachob '494 teaches receiving user information associated with the subscriber and storing the information in memory (fig. 2, label 72, col. 5, ll. 58-61), associating a commercial message (claimed advertisement) with the user profile and associating the advertisement with a channel (col. 5-6, ll. 67-6), and displaying on a television the program associated with the channel selected by the subscriber and displaying on the television during a break in the selected program, the advertisement, wherein the advertisement is associated with a different logical channel than the selected program (col. 5-6, ll. 58-23). Further, Wachob '494 teaches switching the commercial which reads on switching the television to the channel associated with the advertisement in that the receiver is switching logical channels with the demultiplexer (col. 5-6, ll. 58-23), Wachob '494 teaches sending the advertisement to the television (col. 6, ll. 18-23), and returning to the channel associated with the selected program after sending the advertisement (col. 2, ll. 33-35).

Regarding claim 7, Wachob '494 teaches receiving the television signal comprising receiving a television signal sent to a plurality of subscribers having different user profiles (col. 5, ll. 10-14, col. 5-6, ll. 56-7) and the step of displaying the advertisement comprises displaying for each of the subscribers the advertisements associated with the subscriber's user profile (col. 5-6, ll. 56-7), whereby different

subscribers watching the same program on the same channel may view different advertisements based on their user profiles (col. 5-6, ll. 56-7).

Regarding claim 8, Wachob '494 teaches a tuner for a means for receiving a television signal (see tuner/demodulator – fig. 2, label 62, col. 6, ll. 7-9), a demultiplexer/decompressor as a means for extracting individual programs from the signal (fig. 2, label 66, col. 5-6, ll. 67-3, col. 6, ll. 13-23), an I/R receiver as a means for receiving program channel selections from a user input device (remote control - col. 6, ll. 9-18), microcontroller along with the demultiplexer/decompressor as a means for sending a program associated with the selection to a television, the program being associated with a first logical channel (col. 5-6, ll. 56-6), and a modulator as a means for sending to the television a commercial associated with a second logical channel (col. 6, ll. 18-23).

Regarding claim 9, Wachob '494 teaches a demultiplexer/decompressor as a means for switching from the first channel to the second channel before the commercial is displayed on the television, and as a means for returning the television to the program after the commercial is displayed (col. 5-6, ll. 56-23, col. 2, ll. 33-35).

Regarding claim 10, Wachob '494 teaches switching channels without any direct input on which advertisement should be displayed (col. 5-6, ll. 56-6), accordingly,

Wachob '494 teaches switching and returning without indicating to a subscriber that the television has changed channels.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,231,494 to Wachob (Wachob '591) in view of U.S. Patent 5,155,591 to Wachob (Wachob '591).

Regarding claim 5, Wachob '494 teaches collecting demographic information such as sex and age group, but is silent on viewing habits of a user. In analogous art, Wachob '591 teaches collecting viewing habits, such as channels/programs viewed, pay-per-view purchases (col. 8, ll. 17-33). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wachob '494 by using viewing habits of a user as taught by Wachob '591 in order to more effectively target different demographically defined audiences.

Regarding claim 6, Wachob '494 teaches associating advertisements with the user profile, but is silent on using a network controller to target the advertisements to

Art Unit: 2623

the subscriber based on the demographic information. Wachob '591 teaches collecting viewing habits, such as channels/programs viewed, pay-per-view purchases (col. 8, ll. 17-33) and sending the data to a headend (col. 8, ll. 46-67) thereby enabling the system to target different demographics (col. 9, ll. 4-10). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wachob '494 by using a network controller to target the advertisements to the subscriber based on the demographic information as taught by Wachob '591 in order to more effectively target different demographically defined audiences.

### ***Conclusion***

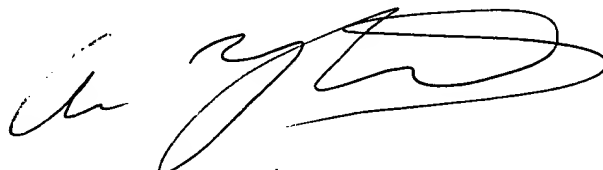
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Fr (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571)272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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